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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/053,040 | 04/01/1998 | ISAO KUDO | KANHA3111.01 | 9807 |

26694 7590 11/19/2002

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EXAMINER

FRECH, KARL D

ART UNIT PAPER NUMBER

DATE MAILED: 11/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/053,040

Applicant(s)

KUDO, ISAO

Examiner

Karl D Frech

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133)
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 07 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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1. The applicant's request for RCE has been entered as paper number 24. The amendment originally filed April 23, 2002 has been entered as paper number 21.

2. Claims 4-6 are objected to because of the following informalities: In claim 4 line 3, "ships" should be --chips--. Appropriate correction is required.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shamir 5,118,369 in view of Wang et al 5,659,167. Shamir discloses, as seen in the previous office actions, a wafer with a plurality of semiconductor dies thereon. It is disclosed that a bar coded label for containing information relative to the individual die is placed on the individual die. These bar codes are on labels are formed in a variety of manners (col 4 lines 24+). Shamir does not specifically disclose two dimensional bar codes. However, such codes are provided by Wang et al as seen in the previous office actions. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use two dimensional bar codes on the labels of Shamir in order to increase the amount of data which can be attached to the individual dies, this is contemplated by Shamir in column 9 lines 30-35. Shamir does not disclose the reading apparatus as claimed. However, bar code readers are old and well known. It would have been

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obvious to a person of ordinary skill in the art at the time the invention was made to provide an appropriate bar code reading system, which includes the optical and processing systems, with the system of Shamir. This would in fact provide for the coded information on the dies of Shamir to be read and utilized. The utilization of the information held on the bar coded die labels is in fact the ultimate use of the bar coded labels as clearly pointed out in the background and summary of Shamir's invention.

5. Applicant's arguments filed April 23, 2002 have been fully considered but they are not persuasive. The arguments provided against the Merlin reference are now moot as Merlin is no longer relied upon for rejection.

6. Applicant argues that there is no suggestion to provide two dimensional bar codes on the dies of Shamir. As seen above, the desire to hold greater amounts of information on the individual dies of Shamir is clearly set forth in Shamir. The use of the two dimensional bar code does just that, and therefore the combination of Shamir and Wang et al suggests to one of ordinary skill the current invention.

7. Applicant argues that there is no reader or information processing systems set forth in Shamir. Although the examiner agrees that the specific devices are not expressly disclosed in Shamir, the disclosure of Shamir clearly calls for such reading and processing devices as the entire Shamir disclosure is directed at containing information regarding the die on a label and being able to at some point access this information. A bar code reader and the ability to process the information held in the bar code is inherent when there is a suggestion that the bar coded

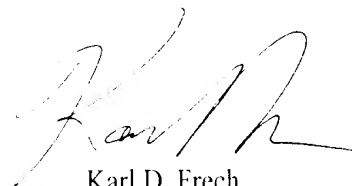
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information held on the bar coded die label is to be used for "administration" (examiner's words) of the die. Applicant does not disclose or claim the specifics of the optical or processing systems of the current invention.

8. The examiner acknowledges the applicant's request for interview regarding the current application. However, despite repeated attempts by both examiner and applicant's counsel, such an interview was not conducted due to timing, scheduling, etc.. Further, in the interest of pendency, this application must be moved from the examiner's office. The examiner remains open to interview prior to final office action, should the applicant / applicant's counsel so wish.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl Frech whose telephone number is (703) 305-3491. The examiner's supervisor is Michael Lee whose telephone number is (703)305-3503. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Tech Center receptionist whose telephone number is (703)308-0956. The Tech Center fax number is (703) 308-7722.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [karl.frech@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.



Karl D. Frech
Primary Examiner, AU 2876
November 17, 2002